

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Applicant: Xhenrong Qian

Application No: 10/082,996

Filing Date: February 26, 2002

Attorney Docket No: 30-4942 USA

Title: PREPARATION OF POLYARYL CARBOXYLIC
ACIDS

Art Group: 1623

Examiner: N/A

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SEP 28 2004

OFFICE OF PETITIONS

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 17, 2004.


Stephen J. Driscoll

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF ABANDONMENT,
AND, ALTERNATIVELY,
PETITION FOR REVIVAL**

I WITHDRAW NOTICE OF ABANDONMENT

Applicants hereby petition for the withdrawal of the Notice of Abandonment issued on June 17, 2004 in connection with the above-identified patent application. The Director is hereby authorized to charge any fees which may be required for this Petition or crediting any overpayment to Deposit Account No. 19-5425.

In summary, Applicant submit that the Notice of Abandonment should be withdrawn for the following alternative reasons: (1) Contrary to the Notice of Abandonment, a proper Reply to the Notice of Missing Parts issued March 26, 2002 was filed on September 20, 2002 along with a four-month extension of time; and (2) Rejecting the application because the

abstract was not on a separate page is extremely draconian under the circumstances since the applicants were not given an opportunity to reply to the Notice of Incomplete reply dated October 11, 2002 which issued more than six (6) months after the Notice to File Missing Parts.

**(1) Applicants Properly Replied to the Notice of Missing Parts
of March 26, 2002**

In response to the Notice of Missing Parts, applicants submitted a reply (herein "Reply") which included not only the Declaration as requested, but also an amendment under 37 C.F.R. §1.111, adding an abstract. A copy of the Reply is submitted here as Exhibit A. As submitted, the amendment complied with 37 C.F.R. §1.121. Section 1.121 states in relevant part:

"Amendments to the specification other than the claims . . . may be made by submitting:

(i) an instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) any replacement or added paragraphs in clean form, that is, without markings to indicate that changes that have been made; and

(iii) another version of any replacement paragraphs, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraphs A marked-up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph was added, or deleted.

Here, we gave clear instructions that a paragraph—i.e., the Abstract—should be added, and submitted that paragraph in "clean" form. Since we were adding the paragraph, there was no requirement to include a marked-up version. Thus, we met the requirements of Section 1.121. There is no requirement in Section 1.121 that the abstract be submitted on a separate sheet. Although such a requirement is set forth in 1.72(b), this regulation is directed at the content of the specification and not at the form of amendments being made to the

specification. Thus, Section 1.121 would seem to be controlling in these circumstances. Accordingly, since we have complied with the principal regulation governing amendments to the specification, we ask the Notice of abandonment and Notice of Incomplete reply be withdrawn and the application proceed to examination.

**(2) Rejecting an Application Because an Amendment Does not
Comply with 37 C.F.R. §1.72(b) is Draconian**

By rejecting the amendment that was filed on September 20, 2002 in the reply to Notice to File Missing Parts, the PTO effectively rejected the application and rendered the application "abandoned." Specifically, by the time the Notice of Incomplete Reply of October 11, 2002 was issued, there was no opportunity to cure the alleged defect in the Reply since the time for responding to the Notice of Missing Parts expired on September 26, 2002. Shortly after the Notice of Incomplete Reply was received on October 16, 2002, Danielle Langdon, under my direction, contacted the PTO to determine what action, if any could be taken, since the application was abandoned technically. The PTO replied that the application had not gone abandoned and that no response was necessary. About six months later, Ms. Langdon again checked the status of the application and again was informed that the application was fine. A memorandum detailing these telephone calls is attached hereto as Appendix C¹. Therefore, since there was nothing the Applicants could do in response to the Notice of Incomplete Reply and since we were assured by the PTO that there was no problem, we submit that holding the application to be abandoned at this point is an extremely harsh, draconian measure. Accordingly, Applicants ask that the rule of reason be followed and that the Notice of Abandonment be withdrawn and the application reinstated immediately. To facilitate this, Applicants are attaching hereto as Exhibit B an abstract on a separate page.

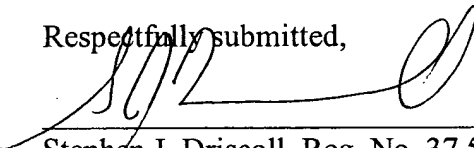
¹Unfortunately, the note which memorialized these telephone calls cannot be located.

Applicants: Qian et al.
Application No. 10/082,996
Page 4

II. REVIVE APPLICATION UNDER 37 C.F.R. §1.137(B)

In the event the Commissioner does not find the arguments above persuasive, applicants hereby petition, in the alternative, to revive the application for unintentional abandonment under 37 C.F.R. §1.137(b). If the Commissioner deems such a petition is required, Applicants respectfully request that the difference between the petition fee under 37 C.F.R. 1.137(b) and the fee for the fourth-month extension of time (\$1,440) which was paid pursuant to filing the Reply, be credited to Deposit Account No. 01-1125.

Respectfully submitted,



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